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No.

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM 1998

WILLIAM BRADSHAW and ROBERT SHEPHERD,
Petitioners,

v.

IGLOO PRODUCTS CORPORATION,
Respondent.

On Petition For Writ Of Certiorari
To The United States Court Of Appeals
For The Federal Circuit

PETITION FOR WRIT OF CERTIORARI

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36pp

QUESTION PRESENTED FOR REVIEW

Whether application of the doctrine of equivalents in a patent infringement lawsuit is a task for the judge or for the jury when there is no prosecution history estoppel, no prior art bar limitations or any express finding that no reasonable jury could find equivalents.

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OPINIONS BELOW

The unpublished panel opinion of the United States Court of Appeals for the Federal Circuit (hereinafter referred to as the "Federal Circuit") sought to be reviewed is not reported. (1a).[1] The order of the Federal Circuit denying the petition for rehearing and suggestion for rehearing in banc is not reported. (11a). The opinion of the United States District Court for the Northern District of Illinois, Eastern Division (hereinafter referred to as the "District Court)", entered in this matter on December 2, 1997 making its opinion of August 25, 1997 final and appealable is not reported. The opinion of the District Court entered in this matter on August 25, 1997 granting the renewed motion of Igloo Products Corporation (hereinafter referred to as "Igloo") for summary judgment is not reported. The unpublished panel opinion of the Federal Circuit entered in this matter on November 15, 1996 is reported at 101 F.3d 716 (Table). The opinion of the District Court entered in this matter on January 5, 1996 granting Igloo's original motion for summary judgment is reported at 912 F.Supp. 1088.

JURISDICTION

The opinion of the Federal Circuit sought to be reviewed was entered on September 18, 1998. (1a). The order of the Federal Circuit denying the Petitioners' petition for rehearing and suggestion for rehearing in banc was entered on October 28, 1998. (11a). The jurisdiction of this Court is invoked under 28 U.S.C. § 1254.

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[1] Citations to the Appendix bound with this Petition shall appear as (___a).

STATUTORY PROVISIONS INVOLVED

35 U.S.C. § 111 provides in pertinent part:

> Application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include (1) a specification as prescribed by section 112 of this title ....

35 U.S.C. § 112 provides in pertinent part:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.
>
> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
>
> * * * *
>
> An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure,

material, or acts described in the specification and equivalents thereof.

35 U.S.C. § 271 provides in pertinent part:

> (a) Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent.

STATEMENT OF THE CASE

Subject matter jurisdiction in the District Court is founded in 28 U.S.C. § 1338(a).

The Petitioners herein, William Bradshaw and Robert Shepherd (hereinafter referred to as "Bradshaw"), had an innovative idea for a cooler on wheels for which they were able to obtain patent coverage. Bradshaw then took this patent to the Respondent herein,Igloo Products Corporation (hereinafter referred to as "Igloo"), a large corporation which would be able to mass produce the product. However, instead of offering Bradshaw a reasonable licensing agreement, Igloo took the design contained in the patent and copied all the elements, except a functional cooling compartment, into an otherwise literally infringing prototype. Igloo created sales based on that prototype and then, prior to distribution of the product, altered it so slightly that its own customers did not notice any difference. Protecting patent holders from minute and insubstantial changes, as occurred in this case, is the reason this Court adopted the doctrine of equivalents in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605 (1950).

In *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17**, 117 S.Ct. 1040 (1997), this Court reaffirmed

the doctrine of equivalents as a viable option for a patent holder to prove infringement in the absence of literal infringement. Although presented with the issue of whether the application of the doctrine of equivalents is a task for the judge or for the jury, this Court previously declined to consider the issue since resolution of the issue was not necessary to answer the central question presented in that case. The time has come, however, for this Court to affirmatively decide this fundamental issue of patent law. In this case, the Federal Circuit applied the all-elements or all-limitations rule, as a rule of law, to deny the patent holder the right to a factual determination by a jury of infringement under the doctrine of equivalents even though there was no prosecution history estoppel, no prior art limitations and no finding that no reasonable jury could find equivalents.

Bradshaw is the owner of U.S. Patent No. 4,873,841, entitled "Portable Cooler", which issued on October 17, 1989 (hereinafter referred to as the "Bradshaw patent"). The application was allowed on the first action of the Patent and Trademark Office with no prosecution history estoppel. The Bradshaw patent improved upon a conventional cooler which typically has a pair of lifting handles attached on opposite sides of the cooler as the only means of transporting the cooler. In contrast, the preferred embodiment of the Bradshaw patent discloses the attachment of a pair of wheels under one end of the cooler body and a pulling handle on the side of the cooler body opposite the wheels. This allows the user to easily pull a loaded cooler along the ground.

In January of 1990, Bradshaw contacted Igloo to determine whether it would be interested in licensing the Bradshaw patent. Through numerous correspondence during the period of January 1990 through April 1992, Bradshaw provided Igloo with several copies of the Bradshaw patent, several drawings of the preferred embodiment, a photograph

of a prototype of the preferred embodiment built by Bradshaw using an Igloo cooler, and a list of various national retailers interested in carrying the product. Despite Bradshaw's constant efforts, Igloo repeatedly refused the invitation to license the Bradshaw patent. Then, in May of 1992, Igloo informed Bradshaw that it had an ice chest with wheels in the design phase despite the fact that Igloo has no independent product development department.

In or about January of 1993, Igloo began the initial design of its Cool Roller product line. Igloo has stipulated that final prototypes of this line of wheeled coolers would have been literally covered by the claims of the Bradshaw patent except for the fact that the prototypes contained a wooden body rather than an insulated cooling compartment. These prototypes were used by Igloo in sales presentations to its top customers to create the first year of sales for the Cool Roller product line. When Bradshaw was made aware of this line of products, Bradshaw and Igloo once again entered into negotiations under which Igloo would purchase a licensing agreement for the Bradshaw patent. When the negotiations failed in or about November of 1993, Igloo's President told Igloo's Director of Engineering to separate the lifting handle and the pulling handle on the Cool Roller products from the same axis.

Igloo continued to copy the essential components of the Bradshaw patent when it modified the Cool Roller products. In an attempt to maintain the functionality of the Bradshaw patent, Igloo discovered through its research that the placement of the pulling handle, one of the innovative components of the Bradshaw patent, could not be altered due to simple human ergonomics. Igloo, therefore, moved the placement of the conventional lifting handle and attached it to a separate axle less than one inch below the axle for the pulling handle. Igloo's Director of Engineering testified that Igloo moved the lifting handle down the minimum distance

possible so as to maintain the maximum functionality of the product. The modified Cool Roller products were then shipped to Igloo's customers without notification that a change had been made from the prototype on which sales were based. The changes in the Cool Roller products were so insubstantial that Igloo's top customers signed affidavits stating they did not realize any changes had been made or that only insubstantial or cosmetic changes had been made between the prototype and the product received. In fact, Igloo stipulated to the mechanical equivalence between the final Cool Roller products and the Bradshaw patent.

Believing the Cool Roller products still infringed upon the Bradshaw patent, Bradshaw filed the original complaint in this action on October 28, 1994 alleging infringement both literally and under the doctrine of equivalents.[2]

On January 5, 1996, the District Court entered a Memorandum Opinion and Order in this matter granting summary judgment in favor of Igloo. The District Court held that, in light of prior art, Igloo's Cool Roller products did not infringe the Bradshaw patent either literally or under the doctrine of equivalents. Bradshaw timely filed an appeal from the District Court's decision.

On November 15, 1996, the Federal Circuit, in *Bradshaw v. Igloo Products Corp.*, 101 F.3d 716 (Fed. Cir. 1996) (Table), issued an opinion affirming the District Court's finding that Igloo's products do not literally infringe the Bradshaw patent. In its opinion, the Federal Circuit construed the claims of the Bradshaw patent to require: an insulated cooler with lifting handles on each end of the

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[2] The complaint also alleged infringement by Igloo of the Bradshaw patent by its Kool Locker a/k/a Rolling Kool Locker products. All claims in the complaint related to those products were subsequently dismissed without prejudice.

cooler; wheels attached to the bottom of the cooler on one end of the cooler; and a pulling handle attached to the lifting handle axle on the end of the cooler opposite the wheels. The Federal Circuit concluded that Igloo's Cool Roller products literally meet all but one element of the independent claims of the Bradshaw patent, specifically, the element requiring that the pulling handle be attached on the same axle as the lifting handle, and affirmed the District Court's finding of no literal infringement. The Federal Circuit, however, vacated the District Court's grant of summary judgment in favor of Igloo regarding possible infringement under the doctrine of equivalents and remanded the case back to the District Court for further consideration with explicit instructions regarding the prior art analysis.

On August 28, 1997, the District Court entered a Memorandum Opinion and Order granting Igloo's renewed motion for summary judgment as to its Cool Roller products finding that infringement under the doctrine of equivalents was barred by prior art. In rendering its opinion, the District Court ignored the explicit directions provided by the Federal Circuit regarding a proper prior art analysis. Bradshaw timely filed an appeal from the District Court's decision.

On September 18, 1998, the Federal Circuit in *Bradshaw v. Igloo Products Corp.*, Appeal No. 98-1157, issued the opinion which is sought to be reviewed. (1a). Although the Federal Circuit indicated that the District Court had once again erred in its analysis of the prior art, the Federal Circuit applied an alternative rule of law and affirmed the District Court's decision. There are only three known rules of law under which a patent holder may be denied a jury determination of equivalence: prosecution history estoppel, prior art and a determination that no reasonable jury could find equivalence. Despite none of these rules of law being applicable in this case, the Federal

Circuit held, "[T]he doctrine of equivalents may not legally cover the accused Cool Roller device." (9a). The Federal Circuit went on to hold, as a matter of law, that:

> [O]ne element of the...[Bradshaw] patent must be a handle support axle to which both a lifting handle and a pulling handle are attached. That element or limitation is entirely missing in the accused cooler and thus equivalent infringement fails under Pennwalt's all-elements or all-limitations rule. See Pennwalt, 833 F.2d at 935, 4 USPQ2d at 1740. (10a).

Under the guise of applying an alternative rule of law, the Federal Circuit essentially made a factual determination as to equivalents. Such a determination should be in the province of the fact-finder, more specifically, the jury. Clearly, in a case such as this where the alleged infringer admitted equivalence, a reasonable jury could find infringement under the doctrine of equivalents. Denying a patent holder the right to a factual determination of equivalents by a jury serves a grave injustice.

On October 1, 1998, Bradshaw timely filed a petition requesting that the Federal Circuit rehear this matter and suggesting that the matter be reheard in banc. An order was entered by the Federal Circuit on October 28, 1998 denying Bradshaw's petition. (11a).

ARGUMENT SUPPORTING ALLOWANCE OF THE WRIT

I. THERE IS A DISTINCT DIVISION BETWEEN THE JUSTICES OF THE FEDERAL CIRCUIT REGARDING WHETHER THE APPLICATION OF THE DOCTRINE OF EQUIVALENTS IS A TASK FOR THE JUDGE OR THE JURY.

In *Warner-Jenkinson*, this Court specifically held that the essential inquiry under the doctrine of equivalents is, "Does the accused product or process contain elements identical or equivalent to each claimed element of the patented invention?" *Warner-Jenkinson*, 520 U.S. at **, 117 S.Ct. at 1054. This approach to the doctrine of equivalents is, in essence, the same principle which has been applied by the Federal Circuit for more than a decade as the all elements or all-limitations rule (hereinafter referred to as the "all-elements rule"). *See, e.g., Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931 (Fed. Cir. 1987) (in banc) and *Perkin-Elmer Corp. v. Westinghouse Elec. Corp.*, 822 F.2d 1528 (Fed. Cir. 1987).

This Court has made clear that the precise linguistic framework used when applying the doctrine of equivalents is irrelevant and is likely to vary depending upon the particular facts of the case. *Warner-Jenkinson*, 520 U.S. at **, 117 S.Ct. at 1054. This Court noted, however, that:

> An analysis of the role played by each element in the context of the specific patent claim will thus inform the inquiry as to whether a substitute element matches the function, way, and result of the claimed element, or whether the substitute element plays a role substantially different from the claimed element. *Id.*

In *Warner-Jenkinson*, this Court declined to take the final step and determine who is to perform such an analysis - the judge or the jury.

Sitting in banc, in the decision underlying this Court's decision in *Warner-Jenkinson*, a majority of the Federal Circuit held that, "Infringement, whether literal or under the doctrine of equivalents, is a question of fact." *Hilton Davis Chemical Co. v. Warner-Jenkinson Co., Inc.*, 62 F.3d 1512, 1520 (Fed. Cir. 1995) (in banc), *rev'd and remanded on other grounds*, 520 U.S. 17, 117 S.Ct. 1040 (1997). That majority of the Federal Circuit, seven justices in total, believed that the holding was made abundantly clear and was wholly supported by its own precedent and prior decisions of this Court. *Id.* at 1520, 1521. The majority left no room for doubt in the meaning of its holding by stating:

> ...[I]nfringement under the doctrine of equivalents is an issue of fact to be submitted to the jury in a jury trial with proper instructions, and to be decided by the judge in a bench trial. *Id.* at 1522.

There were, however, four justices who disagreed with the majority and wrote extensive and detailed dissenting opinions stating that the doctrine of equivalents is an equitable remedy to be determined solely by a judge. *See* dissenting opinion written by Circuit Judge Plager, with whom Chief Judge Archer Circuit Judges Rich and Lourie joined, *Hilton Davis*, 62 F.3d at 1536; and the dissenting opinion written by Circuit Judge Lourie with whom Circuit Judges Rich and Plager joined, *Hilton Davis*, 62 F.3d at 1545. Additionally, one justice stated in a separate opinion that the application of the doctrine of equivalents involves questions of both law and fact: the meaning of the claims is a question of law and the scope of protection afforded a patent is a question of law, but whether an accused product

meets each limitation of a claim either literally or by equivalents is a question of fact. *See* dissenting opinion written by Circuit Judge Nies, *Hilton Davis*, 62 F.3d at 1550.

This is not an instance in which it is appropriate to leave the Federal Circuit to its own devices in settling an important question of patent law. The Federal Circuit, in *Hilton Davis*, plainly did not feel itself empowered to solve the problems presented by the application of the doctrine of equivalents. Instead, at virtually every turn, each judge invoked what he or she regarded as binding precedent of this Court in concluding whether the task is one for the judge or the jury.

Amid this background, patentees are subject to the uncertainty of their case being decided based upon the potentially conflicting beliefs of the individual members of the panel randomly selected to hear their case. Without a determination of this issue by this Court, patent law is subject to inconsistent and contradictory decisions concerning a fundamental issue of patent law. These ramifications can be no more apparent than in this case.

II. THE LACK OF A DETERMINATION BY THIS COURT OF WHETHER THE APPLICATION OF THE DOCTRINE OF EQUIVALENTS IS A TASK FOR THE JUDGE OR THE JURY IS CREATING UNCERTAINTY IN A FUNDAMENTAL AREA OF PATENT LAW.

This case came before the Federal Circuit on a motion for summary judgment of noninfringement which was erroneously granted for the second time by the District Court on the basis of prior art. The Federal Circuit, however, took it upon itself to affirm the District Court's decision by applying the all-elements rule, an issue which

was neither raised in the District Court as a basis for summary judgment, nor briefed by the parties for the appeal. The Federal Circuit held, "[T]he doctrine of equivalents may not legally cover the accused Cool Roller device." (9a). The Federal Circuit went on to hold, as a matter of law, that:

> [O]ne element of the...[Bradshaw] patent must be a handle support axle to which both a lifting handle and a pulling handle are attached. That element or limitation is entirely missing in the accused cooler and thus equivalent infringement fails under Pennwalt's all-elements or all-limitations rule. See Pennwalt, 833 F.2d at 935, 4 USPQ2d at 1740. (10a).

It is a well-settled principle that one-to-one correspondence between components of the accused device and the claimed invention is not required for a finding of equivalents. *Ethicon Endo-Surgery, Inc. v. United States Surgical Corp.*, 47 USPQ2d 1272, 1280 (Fed. Cir. 1998) citing *Sun Studs, Inc. v. ATA Equipment Leasing Inc.*, 872 F.2d 978, 989 (Fed. Cir. 1989), *overruled on other grounds*, and *A.C. Aukerman Co. v. R.L. Chaides Const. Co.*, 960 F.2d 1020, 1038-39 (Fed. Cir. 1992); See also *Dolly, Inc. v. Spalding & Evenflo Companies, Inc.*, 16 F.3d 394, 398 (Fed. Cir. 1994) citing *Intel Corp. v. U.S. International Trade Com'n*, 946 F.2d 821, 832 (Fed. Cir. 1991) and *Vaupel Textilmaschinen KG v. Meccanica Euro Italia S.P.A.*, 944 F.2d 870, 882 (Fed. Cir. 1991). It is possible for an accused device to infringe by equivalents even though two physical components of the accused device perform a function which is performed by a single element in the patented invention. *Ethicon*, 47 USPQ2d at 1280, and *Dolly*, 16 F.3d at 398, citing *Intel*, 946 F.2d at 832.

The Federal Circuit's application of the all-elements rule as a matter of law in this case directly contradicts the Federal Circuit's decision in *Ethicon*, a case decided less than three months prior to this case. In *Ethicon*, the Federal Circuit addressed its application of the all-elements rule in a series of recent cases. Referring specifically to the cases cited in the parties' briefs, the Federal Circuit stated:

> *Dolly*, *Weiner* (*v. NEC Electronics, Inc.*, 102 F.3d 534 (Fed. Cir. 1996)), and *Sage* (*Products, Inc. v. Devon Industries, Inc.*, 126 F.3d 1420 (Fed. Cir. 1997)) were decided on their facts, and were consistent with both our precedent and with the Supreme Court's recent express adherence to the doctrine of equivalents as a viable alternative to literal infringement. They simply explained that on the facts presented, no reasonable finder of fact could have found infringement by equivalents because the differences between the allegedly infringing devices and the claimed invention were plainly not insubstantial." *Ethicon*, 47 USPQ2d at 1278.

As in this case, the *Ethicon* case was before the Federal Circuit on appeal of a grant of summary judgment. The panel in *Ethicon* reviewed the factual findings made by the district court and concluded that, with respect to one of the patent claims, the grant of summary judgment was appropriate under the all-elements rule. *Id.* at 1279. In regard to the second claim of the patent at issue, the panel in *Ethicon* once again reviewed the factual findings of the district court. The panel noted that counsel for the alleged infringer acknowledged during oral argument that the physical difference between the accused product and the patent was very slight. *Id.* at 1280. The panel, therefore, held:

> Thus, we cannot say as a matter of law that this difference is substantial. It is a subtle difference in degree, not a clear, substantial difference or difference in kind....In light of this small difference...the Collins (the patentee's expert) declaration raises genuine issues of material fact as to equivalence, issues that must be resolved by the finder of fact. *Id.*

Accordingly, the grant of summary judgment of noninfringement under the doctrine of equivalents was reversed as to that claim and that portion of the case was remanded for the fact finder to determine whether the structures of the accused product and the patented product were equivalent. *Id.*

In contrast, at no point in its opinion did the panel in this case hold that no reasonable jury could find the differences between the handle axles on Igloo's Cool Roller products and the Bradshaw patent to be insubstantial. Instead, the panel improperly substituted itself in place of the fact finder and made a factual determination regarding equivalence when it held that an element of the Bradshaw patent was entirely missing in Igloo's Cool Roller products. In its decision in this case, the panel ignored all precedent granting the fact-finder the authority to determine, when an element or limitation of the patent is literally missing, whether a substitute element is present in the accused product which matches the function, way, and result of the element claimed in the patent, or whether the substitute element plays a role substantially different from the claimed element.

Ethicon and the cases cited therein unambiguously state that an analysis pursuant to the all-elements rule requires a determination, based on the specific facts of the case, of whether each element of the patented invention is

present in the accused product either literally or by its equivalent. Given this background, the panel in *Ethicon*, reviewed the district court's application of the all-elements rule under the standard of whether a reasonable jury could find equivalence. In this case, the panel itself made the determination regarding equivalence as a matter of law thereby removing such a determination from a reasonable jury.

These cases illustrate the uncertainty developing in this fundamental area of patent law. Depending upon the panel of the Federal Circuit hearing an appeal in a patent case on any given day, the patentee may be entitled to a determination of whether a reasonable jury could find equivalence or a determination by the panel itself, as a matter of law, of what constitutes equivalence. This is an untenable situation which will only be resolved when this Court determines whether the application of the doctrine of equivalents is a task to be performed solely by the jury.

III. SUFFICIENT EVIDENCE WAS PRESENTED IN THIS CASE FROM WHICH A JURY COULD MAKE A FINDING OF INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS.

Bradshaw provided ample evidence from which a reasonable fact finder could conclude that the elements of the Bradshaw patent not literally satisfied by Igloo's Cool Roller products are present by an equivalent, including the following:

(1) A stipulation from Igloo as to mechanical equivalents between the Bradshaw patent and the Cool Roller products;

(2) An uncontradicted affidavit from Bradshaw's expert, Dr. Crispin Hales, a mechanical engineer, containing: (a) an element-by-element comparison of the claims of the Bradshaw patent and the components of Igloo's Cool Roller products, and (b) a conclusion that there are either no or insubstantial differences between every element of the Bradshaw patent claims and the Cool Roller products;

(3) Deposition testimony from Igloo's President and Director of Engineering regarding the efforts taken by Igloo to maintain functional equivalence between its Cool Roller prototype and the Cool Roller products; and

(4) Affidavits from Igloo's customers stating they did not realize any changes had been made or that only insubstantial or cosmetic changes had been made between the prototype and the product received.

The Federal Circuit stated in *Sage* that the doctrine of equivalents protects a patent holder from infringement where only minor or insubstantial changes have been made from a claimed invention while retaining its essential functionality. *Sage*, 126 F.3d at 1424. It is difficult to imagine a less significant difference between a claimed device and an accused device. Plainly, the handle axles on Igloo's Cool Roller products retain the "essential functionality" of the single axle of the Bradshaw patent. Both configurations enable the lifting and pulling handle to be easily rotated about a handle axle enabling a user to easily and comfortably pull the portable cooler. A reasonable jury could find that the differences between Igloo's Cool Roller products and the Bradshaw patent are insubstantial. Therefore, it was beyond the power of the

Federal Circuit to determine, as a matter of law, that the two axle configuration on Igloo's Cool Roller products cannot be equivalent to the single axle configuration of the Bradshaw patent.

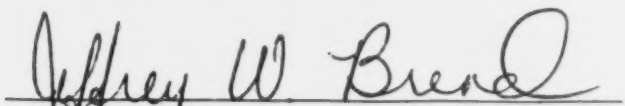
CONCLUSION

This Court has made clear that the essential inquiry under the doctrine of equivalents is whether the accused product contains elements identical or equivalent to each claimed element of the patented invention. What this Court has not made clear is whether such an inquiry is the task of the judge or the jury. Although a majority of the Federal Circuit has held that the inquiry under the doctrine of equivalents is a question of fact to be determined by the jury, Bradshaw was denied the right to such a jury determination under the guise of the all-elements rule being applied as a matter of law.

The all-elements rule simply requires a determination of whether every element or limitation of the patented invention or its equivalent is present in the accused device. See *Perkin-Elmer*, 822 F.2d 1528 (Fed. Cir. 1987), and *Pennwalt*, 833 F.2d 931 (Fed. Cir. 1987) (in banc). This is nothing more than what this Court has deemed to be the essential inquiry under the doctrine of equivalents. For the majority of the Federal Circuit to hold such an inquiry to be a matter of fact and for a panel of the Federal Circuit to hold, in essence, that such an inquiry is a matter of law, creates an untenable uncertainty regarding a fundamental issue of patent law.

WHEREFORE, for all the above reasons, the Petitioners request that this Petition for Writ of Certiorari be granted.

Respectfully submitted,



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